

O-324-13

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1287829
IN THE NAME OF GLOBAL VINTNERS HOLDINGS LIMITED

AND

AN APPLICATION UNDER NO 84399 FOR REVOCATION THEREOF
BY DOMINIC WINES

Background

1. Registration No 1287829 stands in the name of Global Vintners Holdings Limited (“the registered proprietor”) and is for the trade mark PETER DOMINIC. It has a filing date of 17 October 1986 and completed its registration procedure on 15 January 1988. It is registered in respect of the following goods:

Alcoholic beverages included in Class 33.

2. On 19 April 2012, Dominic Wines (“the applicant”) filed an application seeking to revoke the registration. An amended application, amended only in respect of the identification of the alleged period of non-use, was filed on 3 May 2012. The application seeks revocation of the registration on the grounds that the trade mark has “not been put to genuine use within the period specified by the proprietor or with their consent, and it is submitted that there are no proper reasons for this non-use”. The form by which the application is made indicates that revocation of the mark is sought with effect from 24 February 2012.

3. The registered proprietor filed a counterstatement in which it claimed that the trade mark was in use in relation to “wines” and indicated that the applicant had been made aware of that use before its application was made.

4. Both parties filed evidence and written submissions. Neither party sought to be heard. I give this decision after a careful review of all the papers before me.

The evidence

Registered proprietor’s evidence in chief

5. This takes the form of a witness statement dated 2 August 2012 by Tracey Morgan-Kent. Ms Morgan-Kent states she is a director of Ecorps Managers Limited which “is the sole director of the registered proprietor”.

6. Ms Morgan-Kent states that the registered proprietor has used its mark continuously throughout the UK since 2001 “through our sister company Viniberia S.A.U on a royalty basis”. At TMK3 she exhibits a copy of a letter which she states authorises Viniberia S.A.U to use the mark. The letter shows the registered proprietor’s name on headed paper and is addressed to Viniberia S.A.U. It is headed to refer to two trade marks including the one the subject of these proceedings and authorises use of those marks “on your Carta Roja and Tapa Roja wines as sold in the UK and, potentially, in other EU markets” subject to “a Royalty such as may be agreed, from time to time, between us”. The letter is signed by Ms Morgan-Kent and, having signed by him, indicates the terms are accepted by the company Secretary of Viniberia S.A.U. The letter is dated 16 July 2012.

7. Ms Morgan-Kent gives the following details of UK sales bearing the trade mark:

Year	Approximate Annual Turnover (£) Retail	Volume (indicate unit) 75 cl Bottles
2007	£100,000	48,000
2008	£200,000	36,000
2009	£350,000	60,000
2010	£750,000	155,000
2011	£900,000	150,000
2012	£230,000	38,000

8. At TMK1 she exhibits what she states is a photograph of a bottle of wine bearing the trade mark. The exhibit is a print which shows part of a bottle. There are two labels visible. The uppermost label appears crisp, white and pristine and bears the words 2004 GRAN RESERVA TAPA ROJA MONASTRELL and devices. The lower label is gold-coloured and somewhat rubbed around the edges. Whilst the quality of the print means I cannot see everything that is on the lower label, I can see that it includes the words “produced for PETER DOMINIC”. The print is not dated.

9. At TMK2, Ms Morgan-Kent exhibits some twelve invoices. Each is addressed to Ehrmanns Ltd or E I Wines t/a Ehrmanns and is from Viniberia S.A.U. The invoices bear the following dates: 18 June 2007, 5 December 2007, 30 April 2008, 15 December 2008, 22 July 2009, 8 June 2010, 27 May 2011, 4 October 2011, 18 January 2012 and 8 June 2012. Each is for the supply of between 2520 and 3220 of what is described on them as “Carta Roja Gran Reserva 6 x 75cl Produce(d) for Peter Dominic”.

10. Ms Morgan-Kent states that the goods have been promoted primarily at Trade Fairs and through what she describes as “Samples on Stand” at the London International Wine Trade Fair (Excel) in May of each year 2007-2011 inclusive. She gives the following details of expenditure in promoting the mark:

Year	Amount (£)
2007	<£3,000
2008	<£5,000
2009	<£5,000
Tapa Roja 2010	<£5,000
2011	<£5,000
To Feb 2012	<£1,000

Applicant’s evidence

11. This takes the form of a witness statement of Bruce Marsh dated 4 February 2013. Mr Marsh is a Partner at Wilson Gunn, the applicant’s legal representatives in these proceedings. His witness statement serves to introduce a single exhibit, BM1, which is an extract said to have been taken from Wikipedia and which indicates it was downloaded on 16 October 2012. The extract is headed First Quench Retailing and provides a brief history of that company. The history indicates that First Quench

Retailing was “the largest independent off-licence retail chain in the UK, with around 1,200 shops operating under several retail brands, though all have now been closed”. The extract goes on to state:

“The company was originally formed as First Quench Retailing by the merger of the Whitbread owned Threshers and the Allied Domecq owned Victoria Wine in August 1998. This brought together the 1,470 *Thresher Wine Shop*, *Drinks Cabin*, *Wine Rack* and *Huttons* brands with *Victoria Wine Cellars*, *Haddows*, *Martha’s Vineyard*, and *The Firkin*. Allied Domecq later sold their 50% of the company to Punch Taverns in September 1999.

In November 1991, Threshers, then owned by Whitbread alone, bought the Peter Dominic Group from Grand Metropolitan for £50m. The *Bottoms Up* brand of shops, formerly owned by Peter Dominic, was retained. Peter Dominic was separated from GrandMet’s IDV group in 1989 to become a retail division.”

Registered proprietor’s evidence in reply

12. This takes the form of a witness statement of Peter Dauthieu dated 2 April 2013. Mr Dauthieu states he is a beneficiary of a family trust which owns the registered proprietor. He states that Peter Dominic was “registered and first used in late 1939 by [his] father Paul A.S. Dauthieu who, with his wife, founded the Peter Dominic firm of specialist retail wine merchants; Peter Dominic and Co Ltd in Horsham, W. Sussex.” Mr Dauthieu states that the name Peter Dominic was used on retail premises but also on wine, spirits and cider products sold by the company from 1939 onwards. He states:

“From 1945 till 1962 the chain of Peter Dominic Fine Wine retail outlets expanded continuously until the business and its goodwill was acquired by International Distillers and Vintners (IDV, now Diageo). After this IDV converted a large number of Westminster Wine and Fosters off-licences to the Peter Dominic name. Throughout this period and subsequently large numbers of wines and spirits were marketed by Peter Dominic under the Peter Dominic name and Peter Dominic or Dominic(s) labels.

With several hundred off-licences IDV subsequently merged the Peter Dominic shops with Whitbread’s Thresher chain leaving the merged business under Whitbread control. Whitbread proceeded to switch Peter Dominic outlets to the Thresher fascia. Eventually Whitbread merged their Thresher chain (including stores still trading under the Peter Dominic Name) with Victoria Wine with the resultant merged business being called “First Quench” (but with stores trading under all of the above names, Victoria Wine, Threshers and Peter Dominic).

In the late ‘90’s I had the opportunity to acquire the Peter Dominic trade mark from First Quench as this was no longer being used as a trading or brand name. This was acquired by Global Vintners, a Gibraltar registered company controlled by a Trust whose beneficiaries are members of my family.

Since that time the trade mark has been used by other companies whose ownership ultimately comes under Global Vintner's. Currently these are E.I. Wines Ltd t/a Ehrmanns, Viniberia SA (Spain) owned by Viniberia Ltd (UK) in turn owned by Global Vintners Holdings Ltd Gibraltar. I am Chairman of E.I Wines Ltd (and previously Ehrmanns Ltd) and Presidente of Viniberia SA (Spain).

Members of my family are also actively involved in the business, The Peter Dominic name has been used by the above Companies for several years and the intention is to broaden its use in terms of the other wine selling activities.

The Peter Dominic name is very directly associated with me and my family and widely known and publicly recognised."

13. Mr Dauthieu exhibits, at PD1, what he says is a sample label from the Carta Roja Monastrell Gran Reserva 2005 vintage wine showing use of the Peter Dominic mark. The exhibit shows what appear to be two labels, the lower of which includes the words "produced for Peter Dominic".

14. That concludes my summary of the evidence filed.

Decision

15. The application is made under the provisions of section 46 (1)(b) of the Act, the relevant parts of which are re-produced below.

"46 (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) ...

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered, and use in the United Kingdom includes affixing the trade mark to goods or the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after expiry of the five year period and before the application for revocation is made. Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) -

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation;

(b) if the registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that date.

16. The requirements for genuine use were conveniently summarised by Ms Anna Carboni as The Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28. The summary, which I gratefully adopt and re-produce below, is drawn from the judgments of the Court of Justice of the European Union (CJEU) in Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV*, Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar* and Case C-495/07, *Silberquelle GmbH v Maselli-Strickmode GmbH*.

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

17. Section 100 is also relevant and states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. The application seeks revocation of the registration from 24 February 2012. The relevant period within which the registered proprietor must show use of the mark is, therefore, 24 February 2007 to 23 February 2012.

19. I have set out above, in some detail, the evidence filed on behalf of the registered proprietor. Whilst Mr Dauthieu gives a fair amount of detail about Peter Dominic Ltd, he says little about the use of the trade mark the subject of these proceedings other than to say it has been used at some unspecified point since the late 1990s by companies “whose ownership ultimately comes under Global Vintners”, which he says is a Gibraltar company. He does not state, and it is not clear, whether this is the same company as the registered proprietor. He gives details of the companies he says were using the mark at the time his witness statement was made, 2 April 2013. His evidence is silent as to what the position might have been during the relevant period both in terms of any use of the mark and, given the relatively complex nature of the changing ownership of various companies in recent years, who might have been using it, and whether with permission, within the relevant period.

20. Ms Morgan-Kent’s evidence states that the mark has been used continuously throughout the UK since 2001, with that use being through a sister company, Viniberia S.A.U. on a royalty basis. She has exhibited a copy of a letter said to be the authorisation. In its written submissions, the applicant challenges this exhibit and comments that it:

“is not of a nature that would ordinarily be recognised as a formal licence type agreement. Reference is made to a royalty, but there are no specifics which would be the integral component of a licence arrangement”.

21. In its written submissions, the registered proprietor accepts that the letter dates from after the relevant period but submits that it was executed to “regularise an informal arrangement” and that even if not relevant it “is clear that use with the proprietor’s consent does not have to be by way of a formal licence arrangement and the inter-relationship between Viniberia and the registered proprietor is such that consent must be implied”.

22. I agree that the wording of the letter which, as set out above, refers to a royalty “such as may be agreed, from time to time, between us” is neither specific nor, on the face of it, determinable. The letter is dated well after the relevant period and, despite the submission that it regularises a previous, informal, arrangement, there is no evidence of what that informal arrangement might have been. I am not prepared to accept that it shows what the position was during the relevant period.

23. There is no evidence of what, if any advertising has taken place. Ms Morgan-Kent provides promotion figures but only in terms of them being “less than” e.g. £3,000. How much “less than” is a matter of conjecture. She states that promotion was “primarily” carried at the annual Wine Trade Fair in London though does not give any indication of any other form of promotion having taken place. In relation to the promotion at the Wine Trade Fair, other than stating that this was through “samples on stand”, she gives no indication of what these samples might have been or any other information which allows me to establish who or how many people might have attended those fairs nor are any details given of what they were shown or that they were even made aware of the mark.

24. Ms Morgan-Kent has provided turnover figures for the years 2007-2012. Those figures are said to be approximations. With the exception of 2012, the figures provided show a significant increase year on year. Despite this apparently marked growth in sales, the only evidence which has been provided are some twelve invoices not all of which are dated within the relevant period. The invoices are each on Viniberia S.A.U. headed paper and are addressed to Ehrmanns Ltd or E I Wines t/a Ehrmanns. Mr Dauthieu’s evidence is that these are all companies “whose ownership comes under Global Vintners”. I have commented above on the lack of certainty as to whether this is the same company as the registered proprietor (he refers to the registered proprietor’s name in full later in his witness statement) but in any event, this would appear to be internal use and, certainly there is no evidence that any goods bearing or sold under the mark have reached the market or end-user.

25. In addition, the goods on the invoices are listed as being Carta Roja Gran Reserva and indicate that they are “produced for Peter Dominic”. The prints showing part of a bottle exhibited by both Ms Morgan-Kent and Mr Dathieu, also show labels which indicate that the product is “produced for Peter Dominic”. These prints are not dated. The company Peter Dominic and Co Ltd is said by Mr Dathieu to have been founded in late 1939. From both Mr Dathieu’s and Mr Marsh’s evidence, that company, or its successors in business, has had a somewhat chequered history however, the use of “produced for”, whether on the bottle itself or the invoices, appears to me to be indicative only of use of the words Peter Dominic as an identifier of a company rather than use of the name as a trade mark.

26. In order for there to be a finding that genuine use has been made of a mark, the use must be consistent with the essential function of a trade mark i.e. it must guarantee the identity of the origin of the goods to the consumer or end-user and it must be by way of real commercial exploitation of the mark on the market for the relevant goods.

27. In short, the evidence provided is insufficient to show that there has been genuine use of the mark, within the relevant period, by the registered proprietor or with its consent. That being so, the application for revocation of the registration succeeds.

Summary

28. The application for revocation made under the provisions of section 46(1)(b) of the Act on the basis of non-use of the mark succeeds. The registration is revoked from 24 February 2012.

Costs

29. The applicant has succeeded and is entitled to an award of costs in its favour. I take note that the evidence filed was not extensive but that it would have taken some time to consider the registered proprietor's evidence, that no hearing took place and that the applicant filed written submissions. I make the award on the following basis:

For preparation of a statement and reviewing the other side's statement:	£300
Fee:	£200
For preparation of evidence and Reviewing the other side's evidence	£600
Written submissions:	£200
Total	£1300

30. I order Global Vintners Holdings Limited to pay Dominic Wines the sum of £1300 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 12th day of August 2013

**Ann Corbett
For the Registrar
The Comptroller-General**